REMARKS

This Application has been carefully reviewed in light of the Final Office Action dated November 30, 2009 (the "*Office Action*"). Claims 1-7, 9, 10, 12, and 13 are pending and rejected. In order to advance prosecution, Applicant amends Claim 1. Applicant respectfully requests reconsideration and allowance of all pending claims.

Claim Rejections - 35 U.S.C. § 101

The Office Action rejects Claims 1-7, and 12-13 because the claimed invention is allegedly directed to non-statutory subject matter. Applicant respectfully traverses the rejections. For purposes of advancing prosecution, however, Applicant amends Claim 1, thereby rendering the rejections moot. Therefore, for at least this reason, amended Claim 1 includes statutory subject matter under 35 U.S.C. § 101 according to the applicable case law. Claim 1 is therefore allowable. Claims 2-7, and 12-13 depend from amended Claim 1 and are therefore allowable.

Claim Rejections - 35 U.S.C. § 103

I. Claims 1-7, 9-10, and 13 are allowable over the proposed Johnson-Oracle/Peoplesoft combination.

Claims 9-10, 1-7, and 13 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 6,067,525 issued to Johnson et al. ("*Johnson*"), in view of Internet documents entitled "Oracle Delivers Global Sales and Marketing Analysis to the Web" ("*Oracle*") or "PeopleSoft Announces Balanced Scorecard for Strategic Decision-Making" ("*PeopleSoft*"). Applicant respectfully traverses this rejection for at least several reasons, as discussed further below.

For example, amended Claim 1 recites:

A method for reporting a value of a key performance indicator comprising:
receiving information identifying a selected key performance indicator to monitor;
identifying at least one business event associated with the selected key performance indicator;
receiving a business event message indicating an occurrence of the business event, the business event message including business data describing the business event;

in response to receiving the business event message, electronically determining, with a processor, the value of the key performance indicator based on the business data; and

displaying the determined value of the key performance indicator via a contextual visualization interface.

The proposed *Johnson-Oracle-Peoplesoft* combination fails to teach, suggest, or disclose every element of amended Claim 1. In particular, the *Johnson-Oracle-Peoplesoft* fails to disclose "receiving information identifying a selected key performance indicator to monitor." In an attempt to remedy the deficiencies in *Johnson*, the Office Action proposes combining *Oracle* with *Johnson* and/or *Peoplesoft*. *See* Office Action, p. 11. However, the Office Action fails to identify the specific elements of *Oracle* and *Peoplesoft* that the Office Action equates with the elements of the rejected amended Claim 1 missing in *Johnson*. Instead, the Office Action alleges that, with respect to *Oracle* "[t]he software provides global access to real time business monitoring information such as sales, forecasting, marketing trends and internet click-stream data to enhance a company's customer intelligence." Office Action, p. 11. The Office Action further alleges that *Peoplesoft* "teach[es] a business monitoring and management application and integrated cause-and-effect perspective on key management processes by providing the capabilities necessary to design and monitor critical success factors and calculate KPI to help managers develop and execute organizational strategy." Office Action, p. 13. These assertions do not explain how either *Oracle* or *Peoplesoft* discloses "*receiving information* identifying a *selected* key performance indicator to monitor," as recited in amended Claim 1 (emphasis added). Thus, the proposed *Johnson-Oracle* combination fails to disclose "receiving information identifying a selected key performance indicator to monitor," as recited in amended Claim 1.

The Office Action further asserts that the relevant claim limitation is "inherently included in the teachings of *Johnson et al / Oracle / Peoplesoft* as indicated above." Office Action, p. 22. As Applicant previously noted in the Pre Appeal Brief Request for Review filed October 29, 2008, p. 5 (the "Pre-Appeal Brief"), "[t]o establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is *necessarily* present in the thing described in the reference." M.P.E.P. § 2112 (emphasis added). "The mere fact that a certain thing *may* result from a given set of circumstances is *not sufficient.*" *Id.* (emphasis added). The Office Action asserts, without any evidentiary support, that "*receiving*

information identifying a *selected* key performance indicator to monitor," is "inherently included in the teachings of *Johnson et al / Oracle / Peoplesoft.*" Office Action, p. 22. As Applicant previously noted, this assertion fails to meet the standard that the matter be "necessarily present" as set forth above.

The Office Action further alleges that elements of Applicant's "receiving information . . ." claim limitation contain non-functional descriptive material. Office Action, p. 22. However, as Applicant discussed in the Pre-Appeal Brief, p. 2, the Office Action provides no statutory or case law basis for treating the relevant claims as "nonfunctional descriptive material" ("NFDM"). The Office Action merely points to M.P.E.P. § 2106.01 for the definition of non-functional descriptive material, but provides no explanation as to why the identified claim elements satisfy this definition. Office Action, p. 22. Applicant respectfully disputes the Office Action's assertion that the "receiving information . . ." element of amended Claim 1 comprises NFDM. Contrary to the Office Action's assertion, amended Claim 1 recites, for example, "*receiving* information identifying a selected key performance indicator to monitor" (emphasis added) and "in response to receiving the business event message, electronically *determining,* using a processor, the value of the key performance indicator based on the business data." (emphasis added). The recited elements thus represent *functional* elements of the claimed methods. There is no basis for treating these functional elements as "*non-functional* descriptive material." Accordingly, a rejection based on identifying Applicant's claim elements as NFDM without further factual or legal support is improper.

Although of differing scope from amended Claim 1, Claims 9 and 10 are allowable for at least analogous reasons. Applicant respectfully requests reconsideration and allowance of amended Claim 1, Claims 9-10, and their respective dependents.

II.   Claims 1-7, 9-10, and 13 are allowable over the proposed Johnson-Battat-Oracle combination.

The Office Action alternatively rejects Claims 9, 1-7, and 13 under 35 U.S.C. § 103(a) as allegedly being unpatentable over *Johnson* in view of *Oracle* and U.S. Patent Number 5,958,012 issued to Battat, et al ("*Battat*"). Applicant respectfully traverses this rejection for at least several reasons, as discussed further below.

Neither *Johnson* nor *Oracle* teach, suggest, or disclose every element of amended Claim 1. *Battat* fails to remedy the deficiencies in *Johnson* and *Oracle*. For example, as discussed above, the proposed *Johnson-Battat-Oracle* combination fails to disclose "receiving information identifying a key performance indicator to monitor." Thus, the proposed *Johnson-Battat-Oracle* combination fails to disclose, teach, or suggest every element of amended Claim 1.

At the outset, Applicant respectfully notes that the Examiner fails to identify within *Battat* the specific elements the Examiner equates with the elements of the rejected claims. Instead, the Examiner cites to the entirety of over a page-and-a-half of text, all of Figure 3, all of Figure 1, each of which are figures showing a significant number of elements, without providing any indication of which elements of the cited reference the Examiner equates with the claimed subject matter. Applicant respectfully notes that "[w]hen a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable." 37 C.F.R. § 1.104(c)(2). Applicant respectfully notes that the principles of compact prosecution require that the Examiner provide a clear indication as to the basis of the Examiner's rejections so that Applicant may fully address the Examiner's rejection and advance prosecution. ("The Office's policy of compact prosecution requires that both examiners and applicants provide the information necessary to raise and resolve the issues related to patentability expeditiously." *Official Gazette Notice*, October 7, 2003). Citing to large portions of a reference without providing Applicant any indication of which elements the Examiner believes teach the claimed subject matter do not advance the cause of compact prosecution. Thus, Applicant respectfully requests that, if the Examiner continues to utilize these references in rejecting any of the claims of this Application, the Examiner *identify the specific elements of Battat that the Examiner equates with the elements of the present claims*.

Returning to the rejection, Applicant respectfully notes that the proposed *Johnson-Battat-Oracle* combination fails to disclose "receiving information identifying a key performance indicator to monitor." In particular, *Battat* discloses a "system and apparatus for visualizing the components of a computer network system as a realistic three-dimensional environment for the purposes of systems and network management." *Battat*, col. 4, ll. 47-50. In addressing amended Claim 1, the Examiner references all of "steps (301), (302), (303), (304), (305), (306), (307), (308), (309), (310), and (311), Fig. 1, Fig. 10j, col. 8-9, col. 15,

lines 22-40)." Office Action, pp. 17-18. Nonetheless, the Examiner fails to provide any explanation as to how the extensive portions of cited text and figures disclose "receiving information identifying a key performance indicator to monitor," as required by amended Claim 1. Accordingly, *Battat* fails to disclose this element of amended Claim 1. As a result, the proposed *Johnson-Battat-Oracle* combination fails to disclose every element of amended Claim 1.

Amended Claim 1 is therefore allowable for at least these additional reasons. Although of differing scope from amended Claim 1, Claims 9 and 10 are allowable for at least analogous reasons. Applicant respectfully requests reconsideration and allowance of amended Claim 1, Claims 9-10, and their respective dependents.
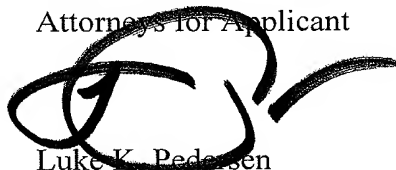
CONCLUSION

Applicant has made an earnest attempt to place this case in condition for allowance. For the foregoing reasons and for other reasons clearly apparent, Applicant respectfully requests reconsideration and full allowance of all pending claims.

If the Examiner feels that a telephone conference would advance prosecution of this application in any manner, the Examiner is invited to contact Luke K. Pedersen, Attorney for Applicant, at the Examiner's convenience at (214) 953-6655.

Applicant believes that no fees are due. However, the Commissioner is hereby authorized to charge any fees or credit any overpayment to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,

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